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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,890	03/09/2004	Gary M. Palmgren	59474US002	5062
32692	7590	12/30/2005		
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER EVERHART, CARIDAD	
			ART UNIT 2891	PAPER NUMBER

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/797,890	PALMGREN ET AL.	
	Examiner	Art Unit	
	Caridad M. Everhart	2891	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 07 October 2005.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4 and 13 is/are rejected.  
 7) Claim(s) 5-12 and 14-16 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6-14-05;12-2-05</u> .	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____.
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### Response to Arguments

Applicant has argued that Manens et al merely teaches the conditioning element of diamond or carbide which is typically used, which applicant has argued is not insulating, but rather held in a metal matrix. This argument is found to be persuasive with respect to the 102 rejection; however, a 103 rejection is made below with references which support the matrix of the conditioning tool being insulative.

Applicant's arguments with respect to claims 1-4 and 13 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manens, et al. (US 6,848,970B2) in view of Basol, et al. (US 2005/0145484 or of Goers (US 6,123,612).

Manens, et al discloses an electrical source (feature 190 in Fig. 1A) with an electrode formed by the pad carrier and a counter-electrode formed by the substrate (col. 7, lines 1-15). There is also a conditioning pad which is insulated from the electrodes because it is disclosed to be formed of diamond or silicon carbide which is patterned to be abrasive (col. 12, lines 17-28), which are dielectric materials which are therefore insulative. This would result in the abrasive surface being electrically isolated from the pad when the conditioning pad is contacting the pad. The system is for electrochemical polishing, as it is disclosed that the system can be for electrochemical dissolution (col. 7, lines 10-12), and as the system has a polishing pad and support which are connected to an electrical source, this electrochemical dissolution is electropolishing. The first and second electrodes may be the cathode and the

anode(col. 7,lines 10-15). It is shown in Fig. 1B that the conditioning tool has a surface and a substrate 258. In Fig. 1B it is indicated that the conditioning disc rotates to condition the surface of the pad when in contact with the pad.

Manens is silent with respect to the matrix of the diamond or carbide conditioning tool.

Basol, et al discloses that the matrix of the conditioning tool is insulting if this is needed in the application in which it is being used(paragraph 0053).

Goers discloses that diamond or silicon carbide particles may be used in the matrix(col. 2, lines 35-48). Goers further discloses that the matrix may be polycarbonate(col. 6, lines 2-10).

It would have been obvious to one of ordinary skill in the art at the time of the invention at the time of the invention to have used the matrix materials disclosed by Basol et al or by Goers in the invention disclosed by Manens et al because both Basol, et al and Goers disclose that insulating matrix can be used according to the need of the application to which the conditioning pad is to be used, and one of ordinary skill in the art would be able to determine that insulating matrix would be desirable in order to not erode the conditioning pad.

#### ***Allowable Subject Matter***

Claims 5-12, 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caridad M. Everhart whose telephone number is 571-272-1892. The examiner can normally be reached on Monday through Fridays 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, B. Baumeister can be reached on 571-272-1722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*C. Everhart*  
CARIDAD EVERHART  
PRIMARY EXAMINER

C. Everhart  
12-27-2005